

REMARKS

The allowance of claim 2 and the indication of allowability of claims 12-16 and 24(2)-26(2) is noted with appreciation.

Claims 10-17 and 24-26 have been amended to overcome the rejection under 35 USC 112, second paragraph.

Claim 1 stands rejected as obvious on Baldwin U.S. Patent No. 3,429,484 in view of Frutin U.S. Patent No. 4,826,054, cited for "axial discharge in Fig. 1."

Independent claim 1 is directed to a hand-held pressurized product dispenser that includes a container with a hand-engageable body portion, a valve mechanism at the top of the container that is movable with respect to the container to cause pressurized discharge of the product, and a valve actuation lever that is connected to the valve mechanism and extends along the container body. Claim 1 further recites that a larger displacement of the end of the lever causes a controlled, relatively smaller displacement of the valve mechanism, permitting adjustable (i.e., "throttled") delivery of the product. Claim 1 further recites that the nozzle outlet is axially aligned with the container to provide axial discharge. As noted at page 5, lines 8-18, the handle provides an ergonomic actuation for device 10, which has axial delivery.

Baldwin discloses a side delivery spray can to which U-shaped clamp 48 and an attached lever actuation mechanism have been attached by a snap connection to permit reuse with other cans. Operating element 79 (the lever) has a rough pivotal connection at "generally rectangular horizontally elongated aperture 72" (col. 2, line 51) through which upward furcation 80 and downward furcation 81 pass "to prevent withdrawal of the actuator from the clamp" (col. 2, lines 55-60). Baldwin notes that the "loose fit of the furcated end portion permits limited vertical pivotal movement of the actuator" (col. 2, lines 60-62). It would appear that pivotal connection at the furcated end would shift around as the lever is pivoted such that there is not a throttling of the type required by the invention claimed herein in claim 1. This does not seem to present a problem in Baldwin, as Baldwin does not mention any type of throttling action, and, would appear to be only interested in typical on/off operation of the type typically used with such spray cans.

C

It is also clear that Baldwin nowhere discloses or suggests the axial direction of the nozzle member as required by claim 5, as was admitted in the office action. In the office action it is stated: "It would have been obvious to one of ordinary skill in the art to provide the axial discharge as taught by Frutin on the device of Baldwin in order to have a different direction of flow out of the device which would better apply the material in certain situations." It, however, would not have been obvious to combine the teachings of Frutin with Baldwin, because they are directed to different types of discharge. The Frutin design is geared toward discharge of silicone compounds where there is concern for the product curing in the valve (col. 2, line 67- col. 3, line 3), while Baldwin is directed toward an aerosol spray head.

Moreover, Frutin, like Baldwin, has on-off operation and does not permit throttling, as in the invention, such that even if one does make the combination, one does not arrive at the invention. To control the flow in Frutin, one instead rotates lock member 28 upward or downward prior to discharge and then operates it in an on/off manner.

The rejection is also flawed because one cannot simply modify Baldwin by replacing the side-spraying valve of Baldwin with a vertical valve, as Baldwin's handle 91 would block the nozzle. Thus, other modifications would be required and there is no suggestion or motivation to make such modifications. Frutin uses an entirely different mechanism for an entirely different purpose. The rejection does not specify what pieces of the Frutin device one would add or exchange with the Baldwin device to arrive at the present invention.

The rejection's generalized statement of a purported motivation to combine and modify the two references also lacks the specificity required by 35 USC 103. As the Federal Circuit recently reiterated in In re Lee, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002)

As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the

C

question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).


"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no

C

knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.



Applicant : Harold Rand Thompson et al.
Serial No. : 09/442,347
Filed : November 17, 1999
Page : 7

Attorney's Packet No.: 00216-468001 / T-670

The combination of Frutin with Baldwin set forth in the rejection is in violation of these principles.

Accordingly the subject matter of independent claim 1 is nowhere suggested by the cited references, and claim 1 is allowable under 35 USC 103(a).

The remaining rejected claims depend on claim 1 and are allowable with claim 1. These claims also add features that further distinguish the cited references.

Applicant also requests consideration of the Supplemental Information Disclosure Statement filed on July 5, 2001, and return of the initialed 1449 form.

Attached is a marked-up version of the changes being made by the current amendment.

Applicant asks that all claims be allowed. Enclosed is \$400 check for the Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: _____

June 12, 2002

William E. Booth

William E. Booth
Reg. No. 28,933

Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Version with markings to show changes made

In the claims:

Claims 10-17 and 24-26 have been amended as follows:

10. (Amended) The dispenser of claim 2 [further comprising a product delivery member attached to said top of said container and having a product holding structure that is positioned with respect to said valve mechanism to receive said product,] wherein said product holding structure has a generally flat upper surface.

11. (Amended) The dispenser of claim 2 [further comprising a product delivery member attached to said top of said container and having a product holding structure that is positioned with respect to said valve mechanism to receive said product,] wherein said product holding structure has a generally arcuate upper surface.

12. (Amended) The dispenser of claim 2 wherein said product holding structure is [a] said porous structure having pores that receive said product.

13. (Amended) The dispenser of claim 2 wherein said product holding structure is [an] said elastomeric applicator.

14. (Amended) The dispenser of claim 2 wherein said product holding structure is [a] said sintered structure.

15. (Amended) The dispenser of claim 2 wherein said product holding structure [has] is said structure having a textured surface.

16. (Amended) The dispenser of claim 2 wherein said product holding structure [has] is said structure having a grid surface.

C

17. (Amended) The dispenser of claim 1[, 3, 7 or 8] further comprising a product delivery member that is attached to said top of said container and has a product holding structure that is positioned with respect to said valve mechanism to receive said product[.,].

24. (Amended) The dispenser of claim 1[, 2 or 3] or 2 wherein said product is a shaving aid.

25. (Amended) The dispenser of claim 1[, 2 or 3] or 2 wherein said product is an antiperspirant.

26. (Amended) The dispenser of claim 1[, 2 or 3] or 2 wherein said product is a deodorant.

C